

**REMARKS**

Claims 1-20 are currently pending in the application. By this amendment, claims 2, 3, 10 and 11 are amended. Support for the amendments is provided in at least page 6, line 11 to page 7, line 6 of the instant specification. No new matter is added.

Reconsideration of the rejected claims in view of the above amendments and the following remarks is respectfully requested.

***35 U.S.C. § 112, second paragraph, Rejection***

Claims 1-7 were rejected under 35 U.S.C. § 112, second paragraph, for being allegedly indefinite.

The Examiner asserts that the limitation reciting the term “preferred” renders the claims vague and indefinite. Applicants respectfully disagree with the assertions of indefiniteness.

Applicants note that the specification clearly and specifically explains what is meant by the language asserted to be indefinite. Applicants note, for example, that the language “preferred viewing order” relates to a viewing order that is defined by the originator and which informs the recipient that the URLs provided in the email should be viewed in a particular order designated by the originator. The term “preferred” is not being used in the way typically found to be objectionable under current USPTO rules, such as when it is used to designate alternative features and/or both broad and narrow definitions of the same recited feature in a claim, e.g., a device comprising a fastener, preferably a screw.

Applicants respectfully submit that one having ordinary skill in the art of email and web browsers, having read the specification, would have no difficulty understand the invention as recited in the claims.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of these claims under 35 U.S.C. § 112, second paragraph.

### **35 U.S.C. § 102 Rejection**

Claims 1-3 were rejected under 35 U.S.C. § 102(e) for being allegedly anticipated by U.S. Patent Application Publication No. 2001/0042098 to GUPTA et al.

In order to establish a *prima facie* case of anticipation under 35 U.S.C. § 102, a single prior art reference must disclose each and every element as set forth in the subject claim. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). Applicants respectfully submit that a *prima facie* case of anticipation has not been established as the applied reference fails to teach each and every element of the claims.

More particularly, claim 1 recites, *inter alia*,

In response to input of the originator, generating a web page navigation that includes a plurality of uniform resource locators and a preferred viewing order in which web pages identified by the plurality of uniform resource locators are to be viewed by the recipient;

associating the navigation with the email; and  
sending the email and the navigation to the recipient.

Additionally, claim 2 recites, *inter alia*,

receiving a web page navigation associated with the email;  
passing the web page navigation to a web browser; and

displaying by the web browser a preferred viewing order in which web pages identified by the web page navigation are to be viewed;  
wherein the preferred viewing order is included in the navigation.

Furthermore, claim 3 recites, *inter alia*,

in response to input of the originator, generating a web page navigation that includes a plurality of uniform resource locators that identify web pages to be viewed by the recipient in a preferred viewing order;

sending the email and the web page navigation to the recipient;

passing the web page navigation to a web browser used by the recipient; and  
displaying by the web browser an indication of the preferred viewing order.

The applied reference does not teach at least these features. Applicants note that GUPTA discloses the sending of an email with an annotation and a user-selectable link allowing the recipient to access the contact associated with the annotation. Such disclosure can be found in paragraph [0013] as follows:

[0013] According to another aspect of the invention, an email message notifying a recipient of a new annotation also includes a user-selectable link for the temporal segment of multimedia content corresponding to the annotation. Upon receipt of the email message, the recipient can select the link and have the media server present, to the user, the temporal segment of multimedia content that corresponds to the annotation.

However, it is clear that this language does not disclose or even suggest that the sent email includes a preferred viewing order, much less, generating, in response to input of the originator, a web page navigation that includes a plurality of uniform resource locators and a preferred viewing order in which web pages identified by the plurality of uniform resource locators are to be viewed by the recipient, and/or displaying by the web browser a preferred viewing order in which web pages identified by the web page navigation are to be viewed, wherein the preferred viewing order is included in the navigation, and/or generating, in response to input of the originator, a web page

navigation that includes a plurality of uniform resource locators that identify web pages to be viewed by the recipient in a preferred viewing order.

Applicant submits that the system in GUPTA is entirely different from that of Applicants' invention. Whereas the invention provides for the sending and/or receiving of emails which include a web page navigation having a preferred viewing order defined by the originator, GUPTA merely discloses that an email can be sent once the originator identifies a particular annotation. Thus, for example, paragraphs [0084] and [0096] of GUTPA state:

[0084] Email field 266 allows the user to input the email address of a recipient of the annotation. The email addresses indicated in field 266 are provided to ABE 132 of annotation server 10, which in turn generates an email message including the newly created annotation and sends the email message to the recipient(s) indicated in field 266 in addition to adding the annotation to the annotation databases. Alternatively, the email message can be sent directly by client 15 of FIG. 1, or by an intermediary server (such as email server 13 of FIG. 1).

[0096] As discussed above, when a new annotation is created, an email message is created and sent to each email address identified in email field 266. The email message is a notification to each of the email recipients (as identified by the email addresses/groups in field 266) of the new annotation. Annotation back end 151 of client 15 includes various identifying information for the annotation and its corresponding media content. Some or all of this identifying information may be made visible to the user, or alternatively may be embedded in header or footer sections of the message that are not displayed to the user.

Furthermore, while it is true that GUTPA discloses that a user can select a "host identifier 306 in email message 306" and that "temporal range information is forwarded to media server 11" such that "[m]edia server then begins streaming the media content to client 15" (see paragraph [0099]), it is clear that this language does not disclose or even suggest that the sent email includes a preferred viewing order, much less,

generating, in response to input of the originator, a web page navigation that includes a plurality of uniform resource locators and a preferred viewing order in which web pages identified by the plurality of uniform resource locators are to be viewed by the recipient, and/or displaying by the web browser a preferred viewing order in which web pages identified by the web page navigation are to be viewed, wherein the preferred viewing order is included in the navigation, and/or generating, in response to input of the originator, a web page navigation that includes a plurality of uniform resource locators that identify web pages to be viewed by the recipient in a preferred viewing order.

Additionally, while the Examiner has identified the steps of Fig. 12 as disclosing the generating, in response to input of the originator, of a web page navigation that includes a plurality of uniform resource locators and a preferred viewing order, a fair review of description describing these steps demonstrates otherwise. Paragraph [0123], for example, states:

[0123] Initially, the annotation server receives an email message with annotation content (step 402). The annotation server analyzes the email message and locates the annotation data in the email message (step 404), generating at least one new annotation from the annotation data in the email message (step 406). The number of annotations generated can vary (e.g., depending on whether the email message is an email thread).

It is clear from such language that while GUPTA discloses receiving “an email message with annotation content”, such language does not disclose that the annotation or annotation content includes a preferred viewing order. Nor does this language disclose, or even suggest generating, in response to input of the originator, a web page navigation that includes a plurality of uniform resource locators and a preferred viewing

order in which web pages identified by the plurality of uniform resource locators are to be viewed by the recipient, and/or displaying by the web browser a preferred viewing order in which web pages identified by the web page navigation are to be viewed, wherein the preferred viewing order is included in the navigation, and/or generating, in response to input of the originator, a web page navigation that includes a plurality of uniform resource locators that identify web pages to be viewed by the recipient in a preferred viewing order. Thus, Applicants respectfully submit that independent claims 1-3 are not disclosed, or even suggested, by any proper reading of GUPTA.

Accordingly, Applicants respectfully submit that the rejection under 35 U.S.C. § 102(b) should be withdrawn.

### **35 U.S.C. § 103 Rejection**

Claims 4-16 were rejected under 35 U.S.C. § 103(a) for being allegedly unpatentable over GUPTA in view of U.S. Patent Application Publication No. 2002/0186239 to KOMURO.

The Examiner acknowledges that GUPTA lacks, among other things recited in the above-noted claims, the recited colors, icons, font characteristics. However, the Examiner explains that such features are taught by KOMURO and that it would have been obvious to combine the teachings of these documents. Applicants respectfully submit that a *prima facie* case of obviousness has not been established as the applied references fail to teach each and every element of the claims.

As explained above, GUPTA is entirely silent with regard to email includes a preferred viewing order, much less, generating, in response to input of the originator, a web page navigation that includes a plurality of uniform resource locators that identify web pages to be viewed by the recipient in a preferred viewing order, as recited in at least claim 3.

However, it is also clear KOMURO is entirely silent with regard to email includes a preferred viewing order, much less, generating, in response to input of the originator, a web page navigation that includes a plurality of uniform resource locators that identify web pages to be viewed by the recipient in a preferred viewing order, as recited in at least claim 3. Indeed, while the Examiner has identified a number of paragraphs in KOMURO as disclosing the language acknowledged to be missing in GUPTA, it is clear from a fair reading of KOMURO that this document merely discloses the updating of a web page when a particular URL is displayed a number of times (see paragraph [0035] of KOMURO).

Furthermore, claim 8 recites, *inter alia*,

in response to input of the originator, generating a web page navigation that includes a plurality of uniform resource locators and a preferred viewing order in which web pages identified by the plurality of uniform resource locators are to be viewed by the recipient;  
associating the navigation with the email; and  
sending the email and the navigation to the recipient.

Additionally, claim 9 recites, *inter alia*,

in response to input of the originator, generating a web page navigation that includes a plurality of uniform resource locators and a preferred viewing order in which web pages identified by the plurality of uniform resource locators are to be viewed by the recipient;  
associating the navigation with the email; and

sending the email and the navigation to the recipient.

Moreover, claim 10 recites, *inter alia*,

receiving a web page navigation associated with the email;  
passing the web page navigation to a web browser; and  
displaying by the web browser a preferred viewing order in which web pages identified by the web page navigation are to be viewed;  
wherein the preferred viewing order is included in the web page navigation.

Further, claim 11 recites, *inter alia*,

in response to input of the originator, generating a web page navigation that includes a plurality of uniform resource locators that identify web pages to be viewed by the recipient in a preferred viewing order;  
sending the email and the web page navigation to the recipient;  
passing the web page navigation to a web browser used by the recipient; and  
displaying by the web browser an indication of the preferred viewing order.

Finally, claim 16 recites, *inter alia*,

in response to input of the originator, generating a navigation that includes:  
a plurality of uniform resource locators that identify web pages to be viewed by the recipient; and  
a color associated with each of the uniform resource locators according to a color code, wherein the color code indicates a preferred viewing order in which the web pages are to be viewed by the recipient; and  
sending the email and the navigation to the recipient.

As the Examiner will note, each of the above-noted claims recite, among other things, an email and/or a navigation which includes a preferred viewing order. On the other hand, as noted above, GUPTA fails to disclose or suggest a preferred viewing order, much less, the sending of an email which includes, among other things, a preferred viewing order.

KOMURO, as explained herein, merely discloses the updating of a web page when a particular URL is displayed a number of times (see paragraph [0035] of



KOMURO) and similarly fails to disclose or suggest this feature, much less, the above-noted features of at least claims 1-3, 8-11 and 16.

Thus, Applicants submit that none of the above-noted claims are disclosed or suggested by any proper combination of these documents.

Furthermore, Applicants submit that there is no motivation to combine the above-noted documents at least because KOMURO fails to cures the deficiencies of GUPTA.

Accordingly, Applicants respectfully submit that the rejection under 35 U.S.C. § 103(a) should be withdrawn.

***New Claim are also Allowable***

Applicants submit that the new claims 17-20 are allowable over the applied art of record. Specifically, claims 17-20 depend from claim 1 and recite a combination of features which are clearly not disclosed or suggested by the applied art of record. Accordingly, Applicants respectfully request consideration of these claims and further request that the above-noted claims be indicated as being allowable.

**CONCLUSION**

In view of the foregoing amendments and remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to

issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed.

Respectfully submitted,  
C. L. BATES, *et al.*

A handwritten signature in black ink, consisting of several overlapping loops and a long horizontal stroke at the end.

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